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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 954,661	09/17/2001	Shinobu Shigeta	2462-129US	7560

7590

05/22/2003

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EXAMINER

NGUYEN, JIMMY

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,661

Applicant(s)

SHIGETA, SHINOBU

Examiner

Jimmy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Argument

The examiner has carefully considered the comparison and contrast on pages 3 and 4 of the applicant's remark with the following effect;

Beside a solution supply device independent from guide needle and the optical identification; the applicant fail to claim the contest provision.

Further, the newly added limitation is in view of the new rejection as below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over B.G.Casner et al (US 3572400) in view of Nadeau (US 4992729)

As to claims 1, 7, 13, B.G.Casner et al disclose (fig 2) a mark forming apparatus comprising:

A guide needle (23) for forming a mark;

A positioning mechanism (17, the position mechanism will be operated by the tester 17) for positioning guide needle (23) above a fault location of a semiconductor device (10);

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A solution supply device (19) for supplying a solution containing a coloring agent and a volatile solvent (column 2 line 21 – 26 and column 2 line 70 –73) to the fault location until it touches a tip of guide needle; and

A heating unit (the use of heat to dry volatile solvent is disclosed in the background of the invention in column 2) for evaporating the volatile solvent to form a mark consisting of the coloring agent surrounding the fault location (as seen in figs 6 and 7).

However, B.G Casner et al is silent on a solution supply device independent from guide needle. On the other hand, Nadeau teaches a solution supply device (11) independent from guide needle (12).

It would have been obvious to one having an ordinary skill in the art at the time of the invention was made to modify Casner's supply device and using Nadeau's supply device independent from the probe tip for the purpose of storing a quantity of marking liquid (COLUMN 2 LINE 25).

As to claims 2, 3, 8, 9, 14, 15. B.G.Casner et al disclose the volatile solvent is any one of ketone, ether and alcohol (column 2 line 21 – 26).

As to claims 4, 5, 10, 11, 16 - 20. B.G.Casner et al disclose the heating unit comprises an irradiating device for irradiating visible rays, and the evaporation of

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the volatile solvent is caused by irradiation of the visible rays (column 9 line 40 – 50, drying the volatile by keeping the oven).

As to claims 6, 12, B.G.Casner et al disclose the guide needle is the probe needle (23).

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Nguyen at (703) 306-5858. Any inquiry of a general nature of relating to the status of this application or proceeding should be

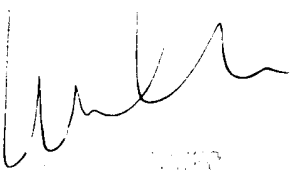
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directed to the Group receptionist whose telephone number is (703) 305-4900.

JN.
May 7, 2003



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